

**REMARKS**

Firstly, Applicants respectfully submit, and it was confirmed by Examiner Thompson in a telephone call on June 13, 2003, that the June 3, 2003 Office Action is not a final Office Action, despite the erroneous indication on page 6, item 6 of the Office Action. The Office Action summary, in the Status section, Item 2b, indicates that the June 3 Office Action is a non-final action.

Claims 1-11 and 13-33 are pending. By this Amendment, claims 1-2, 6-8 and 13-14 are amended. Claim 12 is canceled without prejudice to or disclaimer of the subject matter contained therein. Claims 20-33 are added. No new matter has been added.

Support for the amendments to claims 1 and 8 is found on page 4, lines 4-10 of the specification. The amendments to claims 2, 7 and 14 are formal. The amendments to claims 6 and 13 change their dependencies.

Attached is a copy of an European counterpart of the Doublet reference, published December 20, 1995.

For the following reasons, Applicants submit that this application is in condition for allowance.

**I. REPLY TO REJECTIONS**

On page 2, Item 2 of the Office Action, claims 1-2 and 4-5 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,402,888 to Doublet et al. (hereinafter "Doublet"). The rejection is respectfully traversed.

Applicants respectfully submit Doublet fails to suggest paper based on fiber composition, the paper comprising at least one multitone effect watermark, wherein the watermark, when observed in transmitted light, has a set of dark zones and a set of pale zones arranged in the manner of a screened image, and the pale zones have a weight per unit area of fiber composition that is less than that of the dark zones, as recited in claim 1.

Doublet discloses a sheet of security paper that has localized areas with reduced thickness and opacity with important areas of reduced thickness and opacity in specific determined places (col. 1, lines 9-13). Examples of these important areas of reduced thickness are shown in Fig. 7 as area 20, which is a large rectangular block where the amount of the check can be written. This provides a security measure as the amount of the check can not be erased without damage (col. 5, line 64 – col. 5, line 5). This is consistent with Doublet's disclosures that the thinner regions of the paper webs are constituted in the form of a simple geometric motif, particularly in the form of flat regions which are approximately rectangle, round or elliptical, or in any other form (col. 4, lines 23-26).

As such, Doublet fails to disclose or suggest a set of dark zones and a set of pale zones arranged in a manner of a screened image. Further, in Doublet, there is no disclosure or suggestion that the pale zones have a weight per unit area of fiber composition that is less than that of the dark zones.

Therefore, the thinner regions disclosed in Doublet are not watermarks. Instead, Doublet discloses that the paper has an area which is practically transparent or translucent that is able to be printed on/and or able to receive a hologram or any other distinctive mark or security mark (col. 3, lines 13-20). This disclosure in Doublet, therefore, fails to disclose a watermark that has portions which transmit light and portions which are opaque made directly in the fiber composition. As Doublet must print or make a hologram or a distinct mark which is not made directly in the fiber composition, but is transferred thereon, it cannot be considered to have a watermark.

Consequently, claim 1 is patentable over Doublet. Claims 2 and 4-5, which depend from claim 1, are likewise patentable over the applied reference for at least the reasons discussed above and for the additional features they recite. Withdrawal of the rejection of claims 1-2 and 4-5 is respectfully requested.

On page 3, item 3 of the Office Action, it is alleged claims 1-2 and 4-5 are not patentably distinct from claims 9, 11, 13 and 18 of Doublet. However, like its disclosure discussed above, the claims of Doublet fail to suggest, among others, a set of dark zones and a set of pale zones arranged in a manner of a screened image. Therefore, claims 1-2 and 4-5 are patentably distinct from claims 9, 11, 13 and 18 of Doublet.

On page 3, item 4 of the Office Action, claims 1-2 and 4-5 are rejected under the judicially created doctrine of obviousness-type double patenting rejection over claims 9-11, 13, 17, 18 and 20 of Doublet. The rejection is respectfully traversed.

As discussed above, claim 1 is patentably distinguishable from the claims of Doublet. Specifically, Doublet fails to disclose a set of dark zones and a set of pale zones arranged in a manner of a screened image, and the pale zones have a weight per unit area of fiber composition that is less than that of the dark zones, as recited in claim 1.

Although the Office Action asserts that Doublet discloses that the security paper has an area of reduced opacity of at least  $0.4\text{cm}^2$ , this passage merely indicates the minimum amount of area with the reduced opacity. This passage does not indicate that the area has a weight per unit area that bears any specific relationship to that of another zone.

Therefore, claims 1-2 and 4-5 are patentable. Withdrawal of the rejection of claims 1-2 and 4-5 is respectfully requested.

On page 4, item 5 of the Office Action, claims 1, 3 and 15-19 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 9-11, 13, 17-18 and 20 over Doublet in view of U.S. Patent No. 5,916,416 to Fedrigoni et al. (hereinafter "Fedrigoni"). The rejection is respectfully traversed.

As discussed above, the Doublet claims fail to suggest the features of claim 1. Fedrigoni fails to overcome the deficiencies in Doublet.

Fedrigoni discloses application of a secondary fibrous mix onto a primary fibrous mix by jets that eject the secondary fibrous mix to a relatively fluid layer of the primary fibrous mix, whereby the secondary fibrous mix ejected from the jet displaces small portions of the primary fibrous mix and fills the displaced primary fibrous mix with the secondary fibrous mix to form one amalgamated material. The secondary fibrous mix forms the patterns on the primary mix paper CP (Fig. 8, col. 1, lines 37-63, col. 8, lines 57-64).

Consequently, Fedrigoni also fails to disclose a paper with a set of dark zones and a set of pale zones arranged in a manner of a screened image, and the pale zones have a weight per unit area of fiber composition that is less than that of the dark zones, as recited in claim 1. Consequently, claim 1 is patentable over the applied references. Claims 3 and 15-19, which depend from claim 1, are likewise distinguishable over the applied references for at least the reasons discussed above and for the additional features they recite. Withdrawal of the rejection of claims 1, 3 and 15-19 is respectfully requested.

Additionally, Applicants respectfully request the rejoinder of claims 6-11 and 13-14 as the method disclosed in claim 8 concerns a paper disclosed in claim 1, and claim 8 recites all of the features of claim 1.

Further, new independent claims 20 and 27 recite allowable features of claim 1. Specifically, Doublet merely discloses thinner regions of simple geometric motif, and consequently, fails to disclose a set of pale zones arranged in the manner of a screened image, as recited in claim 20. Further, Doublet fails to suggest a set of pale zones constituted by indentations in the fiber composition and arranged as a screened image, as recited in claim 27. Consequently, claims 20 and 27 and their respective dependent claims are also allowable. Prompt allowance of claims 20-33 is respectfully requested.

**II. CONCLUSION**

For the foregoing reasons, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance are respectfully requested.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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Attachments:

Petition for Extension of Time  
Amendment Transmittal  
EP 0 687 324

Date: October 3, 2003

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